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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,660	03/04/2005	Nobuyuki Tanaka	Q86056	3169
23373	7590	09/25/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER CHO, JENNIFER Y	
			ART UNIT	PAPER NUMBER
			1621	
			MAIL DATE	DELIVERY MODE
			09/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Supplemental  
Notice of Allowability**

Application No.

10/526,660

Examiner

Jennifer Y. Cho

Applicant(s)

TANAKA ET AL.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/4/2005.
2. ☒ The allowed claim(s) is/are 1-4, 8 and 14.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

***Election/Restrictions***

The application as filed required restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-4, 8 and 14 drawn to a compound and process of the general formula (I) and (VII), classified in class 560, subclass 61.
- II. Claims 5-6, drawn to a compound of the general formula (IV), classified in class 568, subclass 626.
- III. Claims 7 and 9, drawn to a compound of the general formula (VI), classified in class 560, subclass 61.
- IV. Claims 10-11, drawn to a compound of the general formula (VIII), classified in class 560, subclass 61.
- V. Claim 12-13, drawn to a process for preparing a compound of the general formula (X), classified in class 514, subclass 543.

Groups I, II, III and IV and permutations of, are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed can have a materially different design, mode of operation, function, or effect. In the instant case, the phenoxyacid derivatives differ in chemical structure, reactivity and use. Furthermore, the inventions as claimed do not

encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Groups (II-IV) and V, and permutations of, are directed to an unrelated products and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the products of groups (II-IV) are not formed or used in the process of making compound of formula (X), from group V.

Groups I-V, and permutations of, are distinct from each other because prior art anticipating or rendering obvious the invention of one group would not necessarily anticipate or render obvious either of the inventions of the other groups. In the instant case, the processes for forming phenoxyacetic acid derivatives can be used to form different phenoxyacetic acid compounds than the ones as shown with structures of the general formula (I), (IV), (VI), (VII), (VIII) and (X).

Restriction as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

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(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant was contacted on 9/4/07 and agreed to elect allowable claims 1-4, 8 and 14, and cancel non-elected claims 5-7, 9-13.

#### **Allowed Claims**

Claims 1-4, 8 and 14 are allowed over the prior art of record.

#### **Examiner's Amendment**

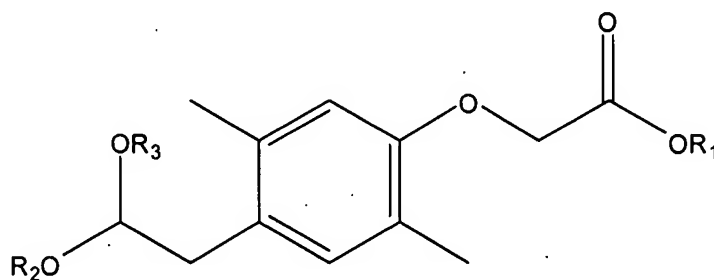
An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

1. Claims 5-7, 9-13 are cancelled.

### Reason for Allowance

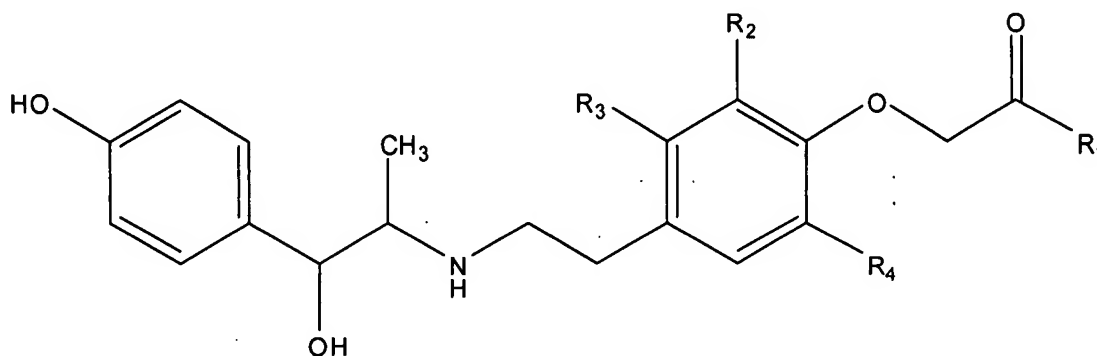
Applicant's claimed invention is directed phenoxyacetic acid derivatives, as shown below, in which R1 and R2 are lower alkyl groups, and R3 is hydrogen or a lower alkyl group.



Formula (I) and (VII)

The closest prior art is Tanaka et al. (EP 1 095 932 A1).

Tanaka et al. teaches phenoxyacetic acid derivatives, represented by the structure below:



Tanaka et al. is deficient in the sense that it does not teach applicant's particular phenoxyacetic acid derivatives.

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Tanaka et al. neither teaches, nor suggests Applicant's phenoxyacetic acid derivatives, as shown above. Nor would it have been obvious to modify Tanaka et al.'s compounds to arrive at the instantly claimed invention. There is no motivation to do so.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Y. Cho whose telephone number is (571) 272 6246. The examiner can normally be reached on 9 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Cho  
Patent Examiner  
Art Unit: 1621

  
Yvonne Eyler  
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